REMARKS

Response to Restriction Requirement

In accordance with Office guidelines recited in MPEP Section 821.04, elected apparatus (product) claims found to recite patentable subject matter may be rejoined with the provisionally withdrawn method of making or use type claims and examined in this one application provided the method of making or use claims recite all the elements found to be patentable during examination of the elected product invention. As such, when the product claims 1-5, 7-17 and 27 are found patentable, applicant requests that the method of making and/use claims 18-26 be rejoined and taken up for examination. Consistent with such intent to rejoin, applicant has amended the method claims, notwithstanding the Office's withdrawal of such claims, to present them in form suitable for future examination upon their rejoinder with the allowed elected claims.

Allowable Subject Matter

Examiner Deo found claims 6-8 and 17 recite allowable subject matter.

Rejections of Claims and Traversal Thereof

In the October 17, 2005 Office Action,

claims 1-5 and 9-16 were rejected under 35 U.S.C. §102(e) as being anticipated by Prasad (U.S. Patent No. 6,913,517).

This rejection is hereby traversed, and reconsideration of the patentability of amended claims herein is requested, in light of the ensuing remarks.

Rejection under 35 U.S.C. §102(e)

In the October 17, 2005 Office Action, claims 1-5 and 9-16 were rejected under 35 U.S.C. §102(e) as being anticipated by Prasad. Applicant respectfully traverses this rejection and submits that the claims, as now amended, are not anticipated by the cited reference.

Applicant has incorporated the subject matter of claim 6 into claim 1, and as such, claim 1 and all claims depending therefrom recite patentable subject matter. Further, method claims 18-22 are also patentable because they recite all the limitations of the patentable product claims.

Applicants' claim 14 is a formulated material used to fabricate a cleaning pad **consisting essentially of**:

a liquid urethane; and

a metal agent.

According to the Office, this formulated material is disclosed in Prasad. Applicant vigorously disagrees since Prasad fails to disclose a formulated material consisting essentially of the components recited in the claim.

Anticipation under 35 U.S.C. § 102 requires the presence, in a single reference, of each and every element of the claimed invention, **arranged as in the claim.** *Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Co.*, 221 USPQ 481, 485 (Fed. Cir. 1984). The formulations described by Prasad fail to meet this standard because instead Prasad merely discloses a broad genus of formulations. When the claimed formulation(s) are not specifically named, but instead it is necessary to select portions of teachings within a reference and combine them, e.g., select various components from a list of alternative components to arrive at a specific composition, anticipation can only be found if the classes of different components are sufficiently limited or well delineated. *Ex parte A*, 17 USPQ2d 1716 (Bd. Pat. App. & Inter. 1990). (MPEP 2131.03).

In the present situation, Prasad teaches a porous foam pad fabricated from polyurethane with a multiplicities of optional components. Thus, one skilled in the art reading Prasad would have to pick one of the many optional components in an attempt to recreate applicant's claimed invention. For example, the formulations of Prasad can include a **"water absorbent polymer"** as described below:

> The porous foam of the polishing pads described herein optionally further comprises a water absorbent polymer. The water absorbent polymer desirably is selected from the group consisting of amorphous, crystalline, or cross-linked polyacrylamide, polyacrylic acid, polyvinylalcohol, salts thereof, and combinations thereof. Preferably, the water absorbent polymers are selected from the group consisting of cross-linked polyacrylamide, cross-linked polyacrylic acid, cross-linked polyvinylalcohol, and mixtures thereof.

Further, the porous foam pad may include one of the many **"soluble particles"** as set forth below:

The porous foam of the polishing pads described herein optionally contains soluble particles incorporated into the body of the pad. Preferably, the soluble particles are dispersed throughout the porous foam. Such soluble particles partially or completely dissolve in the liquid carrier of the polishing composition during chemical-mechanical polishing. Typically, the soluble particles are water-soluble particles. For example, the soluble particles can be any suitable water-soluble particles such as particles of materials selected from the group consisting of dextrins, cyclodextrins, mannitol, lactose, hydroxypropylcelluloses, methylcelluloses, starches, proteins, amorphous non-cross-linked polyvinyl alcohol, amorphous non-cross-linked polyvinyl pyrrolidone, polyacrylic acid, polyethylene oxide, water-soluble photosensitive resins, sulfonated polyisoprene, and sulfonated polyisoprene copolymer. The soluble particles also can be an inorganic water-soluble particles of materials selected from the group consisting of potassium acetate, potassium nitrate, potassium carbonate, potassium bicarbonate, potassium chloride, potassium bromide, potassium phosphate, magnesium nitrate, calcium carbonate, and sodium benzoate. When the soluble particles dissolve, the polishing pad can be left with open pores corresponding to the size of the soluble particle.

Still further the porous foam pad may include a "**solid catalyst**" selected from the following group:

The porous foam of the polishing pads described herein optionally contains solid catalysts that are incorporated into the body of the pad. Preferably, the solid catalysts are dispersed throughout the porous foam. The catalyst can be metallic, non-metallic, or a combination thereof. Preferably, the catalyst is chosen from metal compounds that have multiple oxidation states, such as but not limited to metal compounds comprising Ag, Co, Ce, Cr, Cu, Fe, Mo, Mn, Nb, Ni, Os, Pd, Ru, Sn, Ti, and V.

Another component that may be included in the porous foam pad includes "**chelating agents or oxidizing agents**" selected from the group as set forth below:

The porous foam of the polishing pads described herein optionally contains chelating agents or oxidizing agents. Preferably, the chelating agents and oxidizing agents are dispersed throughout the porous foam. The chelating agents can be any suitable chelating agents. For example, the chelating agents can be carboxylic acids, dicarboxylic acids, phosphonic acids, polymeric chelating agents, salts thereof, and the like. The oxidizing agents can be oxidizing salts or oxidizing metal complexes including iron salts, aluminum salts, peroxides, chlorates, perchlorates, permanganates, persulfates, and the like.

Clearly, from the multiplicity of different components set forth in Prasad, identifying an anticipatory formulation would certainly be a serendipitous event because Prasad provides no guidance or suggestion to go in the direction of applicant's claimed invention. There is certainly no anticipation because the disclosure in the reference is so broad that the likelihood of arriving at the presently claimed invention would be the same as discovering the combination of a safe by an inspection of its dials, *Ex parte Garvey*, 41 USPQ 583 (POBA 1939).

Thus, applicant believes that the cited reference would not qualify as a reference under 35 U.S.C. §102 to defeat the novelty of amended claim 14 and all claims depending therefrom. Further, since product claims 14-16 are patentable, then method claims 23 to 26, which include all the limitations of claim 14, should be rejoined and found patentable. Applicant requests the withdrawal of the rejection of all pending claims under 35 U.S.C. 102.

Fees Payable

Applicant has cancelled one dependent claim and added three new dependent claims. Applicant has also added two new independent claims thereby requiring an additional fee of $500.00 ($400.00 for independent claims and $100.00 for two dependent claims). Applicant has included a check in the amount of $500.00. The U.S. Patent and Trademark Office is hereby authorized to charge any additional amount due for entry of this amendment to Deposit Account No. 13-4365 of Moore & Van Allen PLLC.

New Power of Attorney and Change of Correspondence Address

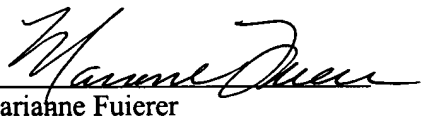
Applicant has included herewith an executed Power of Attorney form that revokes the previously filed Power of Attorney and appoints new representation with a new Attorney Docket Number **020732-173.645 (7495)**. Further, applicant requests a Change of Correspondence, so that all communications from the USPTO will be sent to the following contact and address:

Tristan Fuierer
Moore & Van Allen, PLLC
P. O. Box 13706
Research Triangle Park, NC 27709

Conclusion

Applicant has satisfied the requirements for patentability. All pending claims are free of the art and fully comply with the requirements of 35 U.S.C. §112. It therefore is requested that Examiner Deo reconsider the patentability of all pending claims, in light of the distinguishing remarks herein and withdraw all rejections, thereby placing the application in condition for allowance. Notice of the same is earnestly solicited. In the event that any issues remain, Examiner Deo is requested to contact the undersigned attorney at (919) 286-8089 to resolve same.

Respectfully submitted,



Mariahne Fuierer
Reg. No. 39,983
Attorney for Applicant

Moore & Van Allan, PLLC
Telephone: 919-286-8000
Fax: 919-416-8199